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10/621,557	07/17/2003	Michael Andrew Fischer	050337-1340 (05CXT0076WL)	1331
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THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 600 GALLERIA PARKWAY STE 1500 ATLANTA, GA 30339			MOORE, IAN N	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/621,557	FISCHER ET AL.
	Examiner	Art Unit
	Ian N. Moore	2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 October 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. **60/396,691**, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

In this case, **claim 1, 6, 11 and 16** recites, (said first frame) “**uses a first address as a medium access for said station**”, (said second frame) “**uses said first address as the medium access control address for said station**”, (said third frame) uses a second address as the **medium access control address for said station**”. Claims **3, 8, 13, and 18** recite “**transmitting a fourth frames to said station via said local area network, wherein said fourth frame uses said second address as the medium access control address for said station in said local network**”. However, prior-filed application, Application No. 60/396,691 fails to support above mentioned **BOLD** claimed invention.

In general, applicant's "description of invention section" discloses utilizing of global-unique MAC address according to standard IEEE 802.11 protocol, "A) basic address generation" section discloses transmission of IEE-802 MAC address (i.e. corresponding to creation of first frame per claims), "B) address regeneration" section discloses generation new address causing excessive overhead, "C) address disambiguation for infrastructure networks" discloses associating MAC and AID according to various IEEE 802.11 standards (i.e. corresponding to creation of second frame per claims), and "D)address disambiguation for independent networks and direct communication" discloses changing transmission of MAC addresses if required, distinguishing utilizing random value, creating a new MAC address, and transmission of new addressed (i.e. corresponding to transmission of first and second frames per claims).

In particular, prior-filed provisional application section D, step 1 discloses "nearby satiation solicitation frame", which applicant asserts as "a first frame", but the provisional application fails to support a first frame uses the first address as "the medium access control address". Step 2 discloses "nearby station solicitation frame", which applicant asserts as "a second frame", but the provisional application fails to support a second frame uses the first address as "the medium access control address". Step 3 discloses "a direct management action frame requesting the recipient" to generate the address, which applicant asserts as "a third frame", but the provisional application fails to support a third frame uses the second address as "the medium access control address". Step 4 disclose nearby station receiving "an address change request action frame", which was transmitted by initiator as "a directed management action frame" that requesting to change the address. Thus, "a direct management action frame" transmitted by initiator is received by the nearby station as "an address change request action

frame”, and clearly both frames are the same, which applicant asserts third frame, and the provisional application fails to support a third frame uses a second address **as the medium access control address for said station**. Note that “requesting to generate a MAC address” in the provisional application is not the same as “a third frame using a second address as MAC address for said station”.

Finally, section D, Step 4 discloses as follows:

“station receiving a address changed request action frame <i.e. a third frame> with their MAC address only accept and act on that frame if the random token value matches the value in the last nearby station response frame <i.e. second frame> sent by that station. Otherwise they leave their MAC address unchanged”

Clearly, in view of the above, the provisional application fails to support the claimed invention **“transmitting a fourth frames to said station via said local area network, wherein said fourth frame uses said second address as the medium access control address for said station in said local network”** since there is no “fourth frame”, *inter alia*, being transmitted. *(NOTE-This issues has been raised in previous action).*

Claim Objections

2. Claims 16-20 are objected to because of the following informalities:

Claim 16 recites “**at said via**” in line 13. For clarity, it is suggested to insert “apparatus” between “at said” and “via” (i.e. “at said apparatus via”).

Claim 17-20 also objected since they are depended upon objected claim 16 as set forth above.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-8, 10-13, 15-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Donaghey (US006804232B1).

Regarding Claims 1 and 11, Donaghey discloses an apparatus (see FIG. 1, 2, Hub 110) processing a method (see FIG. 11, method) comprising:

(1) a receiver (see FIG. 2, a receiving means in a RF transceiver 230; see col. 4, line 40-15) for:

(i) receiving a first frame (see FIG. 11, S1120-1130, receiving/listening attached request frame) from a station (see FIG. 1, Personal Electronic Device (PEA) 120) in a local area network (see FIG. 1, in a local network 100; see col. 3, line 17-45), wherein said first frame uses a first address as a medium access control address for said station in said local area network (see FIG. 1,6, request frame uses a MAC/AMAC 610 as medium access control address of a PEA in local network 100; see col. 3, line 60-35,60 to col. 4, line 5; see col. 6, line 50-65; see col. 7, line 60 to col. 8, line 5; see col. 11, line 45-55), and

(ii) receiving a third frame (see FIG. 11, S1150, receiving/listening attach confirmation message) from said station via said local area network (see col. 11, line 58-65;

receiving/listening attached confirmation message from a PEA 120 in local network), wherein said third frame uses a second address (see FIG. 6, 11, a new assigned address is created based on combined address/tag of a MAC/AMAC 610 and stream no. 620), rather than said first address (see FIG. 11, a new assigned address is not the same as MAC/AMAC 610), as the medium access control address for said station in said local area network (see col. 11, line 59-65; a new address is assigned as a new MAC address for PEA 120);

(2) a processor (see FIG. 2, digital control logic (DCL) 220; see FIG. 4, DCL 460) for assigning an association identifier to said station (see col. 4, line 10-42; col. 6, line 50-65; DCL places/assigns stream number 620 to PEA 120); and

(3) a transmitter (see FIG. 2, a transmitting means in a RF transceiver 230; see col. 4, line 40-15) for:

(i) transmitting a second frame (see FIG. 11, S1140, sending an attached assign message) to said station via said local area network (see FIG. 1, to PEA 120 via local network 100; see col. 11, line 59-65), wherein said second frame comprises said association identifier (see FIG. 6, stream no. 620; see col. 6, line 50-65) and uses said first address as the medium access control address for said station in said local area network (see FIG. 11, S1140, assign message includes stream no. and MAC/AMAC 610 of PEA 120 as a new assigned address in a local network; see col. 11, line 55-65);

wherein said second address (see FIG. 6, 11, a new assigned address is created based on combined address/tag of a MAC/AMAC 610 and stream no. 620) is a combination of (1) a portion of said first address (see FIG. 6, AMAC 610) and (2) at least a portion of said association identifier (see FIG. 6, stream no. 620; see col. 10, line 50-65; see col. 11, line 30-65; a new

assigned address is created based on combined address/tag of a portion/share/piece of MAC/AMAC 610 and a portion/share/piece of stream no. 620).

Regarding Claim 6 and 16, Donaghey discloses an apparatus (see FIG. 1, 3, Personal Electronic Device (PEA) 120) processing a method (see FIG. 11, method) comprising:

(1) a transmitter (see FIG. 3, a transmitting means in a RF transceiver 330; see col. 4, line 45-52) for:

(i) transmitting a first frame (see FIG. 11, S1120-1130, see FIG. 12, S1230, sending attached request frame) from said apparatus (see FIG. 1, from Personal Electronic Device (PEA) 120) in a local area network (see FIG. 1, in a local network 100; see col. 3, line 17-45), wherein said first frame uses a first address as a medium access control address for said apparatus in said local area network (see FIG. 1,6, request frame uses a MAC/AMAC 610 as medium access control address of a PEA in local network 100; see col. 3, line 60-35,60 to col. 4, line 5; see col. 6, line 50-65; see col. 7, line 60 to col. 8, line 5; see col. 11, line 45-55; see col. 12, line 20-26), and

(ii) transmitting a third frame (see FIG. 11, S1150, see FIG. 12, S1250, attach confirmation message) from said apparatus via said local area network (see col. 11, line 58-65; see col. 12, line 30-35; sending attached confirmation message from a PEA 120 in local network), wherein said third frame uses a second address (see FIG. 6, 11, a new assigned address is created based on combined address/tag of a MAC/AMAC 610 and stream no. 620), rather than said first address (see FIG. 11, a new assigned address is not the same as MAC/AMAC 610), as the medium access control address for said apparatus in said local area network (see col. 11, line 59-65; a new address is assigned as a new MAC address for PEA 120); and

(2) a receiver (see FIG. 3, a receiving means in a RF transceiver 330; see col. 4, line 45-52) for:

(i) receiving a second frame (see FIG. 11, S1140, see FIG. 12, S1240; receiving an attached assign message) at said apparatus via said local area network (see FIG. 1, at PEA 120 via local network 100; see col. 11, line 59-65; see col. 12, line 25-30), wherein said second frame comprises an association identifier (see FIG. 6, stream no. 620; see col. 6, line 50-65) and uses said first address as the medium control access address for said apparatus in said local area network (see FIG. 11, S1140, assign message includes stream no. and MAC/AMAC 610 of PEA 120 as a new assigned address in a local network; see col. 11, line 55-65);

wherein said second address (see FIG. 6, 11, a new assigned address is created based on combined address/tag of a MAC/AMAC 610 and stream no. 620) is a combination of (1) a portion of said first address (see FIG. 6, AMAC 610) and (2) at least a portion of said association identifier (see FIG. 6, stream no. 620; see col. 10, line 50-65; see col. 11, line 30-65; a new assigned address is created based on combined address/tag of a portion/share/piece of MAC/AMAC 610 and a portion/share/piece of stream no. 620).

Regarding Claims 2,7, 12 and 17, Donaghey discloses said association identifier is unique among the stations that are currently active in said local area network (see FIG. 7A-B, separate/specific/unique steam number is assigned for each active PEA in local network; see col. 7, line 4 to col. 8, line 4).

Regarding Claims 3 and 13, Donaghey discloses transmitting a fourth frame (see FIG. 11, S1160, see FIG. 12, S1260; sending attached confirmation acknowledgment message from a hub) to said station via said local area network (see col. 11, line 65 to col. 12, line 5; to PEA 120

via a local network), wherein said fourth frame uses said second address as the medium access control address for said station in said local area network (see col. 11, line 65 to col. 12, line 5,35-40; confirmation acknowledgment message uses a new address as a new MAC address for PEA 120 in local area network).

Regarding Claims 8 and 18, Donaghey discloses receiving a fourth frame (see FIG. 11, S1160, see FIG. 12, S1260; receiving attached confirmation acknowledgment message at PEA) at said apparatus via said local area network (see col. 11, line 65 to col. 12, line 5; at PEA 120 via a local network), wherein said fourth frame uses said second address as the medium access control address for said apparatus in said local area network (see col. 11, line 65 to col. 12, line 5,35-40; confirmation acknowledgment message uses a new address as a new MAC address for PEA 120 in local area network).

Regarding 5,10, 15 and 20, Donaghey discloses wherein said first address is 48 bits in length (see FIG. 1,6, a MAC 610 as medium access control address of a PEA in local network 100; see col. 3, line 60-35,60 to col. 4, line 5; see col. 6, line 50-65; see col. 7, line 60 to col. 8, line 5; see col. 11, line 45-55; note that it clear that, MAC address must have 48 bits in length; see cited Newton's telecom dictionary per IEE 802 standard, page 411).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4,9,14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donaghey in view of Cannon (US006067444A)

Regarding Claims 4,9,14 and 19, Donaghey discloses association identifier has a length as set forth above in claims 1,6,11 and 15.

Donaghey does not explicitly disclose 11 bits. However, Cannon teaches association identifier has 11 bits in length (see FIG. 6, Frame/stream information (FI) word has 11 bits; see col. 11, line 16-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide 11 bits length, as taught by Cannon in the system of Donaghey, so that it would provide 11 bits wide/worth frame and cycle numbers; see Cannon col. 11, line 20-25.

Response to Arguments

7. Applicant's arguments filed 10- have been fully considered but they are not persuasive.

Regarding claim priority, the applicant argued that, "...the disclosure of provisional application 60/396,691 provides adequate support or enablement under 35 U.S.C 112...the station receiving the address change request then sends a frame with the changed address. See Provisional application, Section D. Even if, the specification word "third frame" and "fourth frame" may not be used in the specification of the provisional application, it is clear to one of ordinary skill in the art that at least four frames are used in at least one disclosed embodiment...the instant application should receive the benefit of the filing date of the provisional application" in page 11-12.

In response to applicant's argument, the examiner respectfully disagrees with argument above.

First, although applicant has identified the support for “a first frame”, “a first frame”, and “a third frame” in section D of the provisional application, the applicant yet fail to identified the disclosure that support “MAC address” is being used in those frames. (Also see detail in paragraph 1 above).

Second, applicant argument that indicates the “a frame with changed address” is not disclosed in section D or anywhere in the provisional application.

In particular, section D, Step 4 discloses as follows:

“station receiving a address changed request action frame <i.e. a **third frame**> with their MAC address only accept and act on that frame if the random token value matches the value in the last nearby station response frame <i.e. **second frame**> sent by that station. Otherwise they leave their MAC address unchanged” (emphasis added)

In view of the above, it is clear that no “frame with changed address” is being transmitted. As conclusion, there is no “**a fourth frame**” and no disclosure of “**transmitting a fourth frames to said station via said local area network, wherein said fourth frame uses said second address as the medium access control address for said station in said local network**” in above cited section D by the applicant, or any where in the provisional application.

In response to argument, applicant not only fails to identify the support for “fourth frame”, but also fails to identify the equivalent of “fourth frame”. The “fourth frame” identifies by the applicant does not exist in the actual disclosure. Since the applicant is unable to specifically identify “a fourth frame”, it is clear that the provisional application does not disclose such limitation. Moreover, applicant arguments can not be considered as disclosure, and the

applicant is hereby requested to specifically indicates a specific disclosures that indicates “transmitting a fourth frames to said station via said local area network, wherein said fourth frame uses said second address as the medium access control address for said station in said local network” and other issues set forth in paragraph 1 above.

In conclusion, it is clear that the applicant has not complied with one ore more conditional for receiving the benefit of an earlier filing date under 35 U.S.C 120, for the reason set forth above and paragraph 1.

Regarding claims 1-5 and 11-15, the applicant argued that, “...claim 1 and claim 11...Donaghey does not disclose, teach or suggest at least...a transmitter for transmitting a second frame wherein said second frame comprises said association identifier and uses said first address as the medium access control address for said station in said local area network; wherein said second address is a combination of (1) a portion of said first address and (2) at least a portion of said association identifier ...with the instant claim, the second address includes a portion of the first address, making the address in **the same range in least one embodiment...”** in pages 13-15,17-19, 21 and 23.

In response to applicant's argument, the examiner respectfully disagrees with argument above.

Donaghey discloses a transmitter (see FIG. 2, a transmitting means in a RF transceiver 230; see col. 4, line 40-15) for: (i) transmitting a second frame (see FIG. 11, S1140, sending an attached assign message) to said station via said local area network (see FIG. 1, to PEA 120 via local network 100; see col. 11, line 59-65), wherein said second frame comprises said association identifier (see FIG. 6, stream no. 620; see col. 6, line 50-65) and uses said first address as the

medium access control address for said station in said local area network (see FIG. 11, S1140, assign message includes stream no. and MAC/AMAC 610 of PEA 120 as a new assigned address in a local network; see col. 11, line 55-65); wherein said second address (see FIG. 6, 11, a new assigned address is created based on combined address/tag of a MAC/AMAC 610 and stream no. 620) is a combination of (1) a portion of said first address (see FIG. 6, AMAC 610) and (2) at least a portion of said association identifier (see FIG. 6, stream no. 620; see col. 10, line 50-65; see col. 11, line 30-65; a new assigned address is created based on combined address/tag of a portion/share/piece of MAC/AMAC 610 and a portion/share/piece of stream no. 620).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **making the address in the same range**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Even if the limitation is being claimed, "**making the address in the same range** in least one embodiment" is certainly not disclosed or supported by applicant's provisional application.

Regarding claims 6-10 and 16-20, the applicant argued that, "...claim 6 and claim 16...Donaghey does not disclose, teach or suggest at least... transmitting a third frame from said apparatus via said local area network wherein said third frame uses a second address rather than said first address as the medium access control address for said apparatus in said local area network... with the instant claim, the second address includes a portion of the first address, making the address in **the same range** in least one embodiment..." in pages 16-17,19-2, 22, 23.

In response to applicant's argument, the examiner respectfully disagrees with argument above.

Donaghey discloses transmitting a third frame (see FIG. 11, S1150, see FIG. 12, S1250, attach confirmation message) from said apparatus via said local area network (see col. 11, line 58-65; see col. 12, line 30-35; sending attached confirmation message from a PEA 120 in local network), wherein said third frame uses a second address (see FIG. 6, 11, a new assigned address is created based on combined address/tag of a MAC/AMAC 610 and stream no. 620), rather than said first address (see FIG. 11, a new assigned address is not the same as MAC/AMAC 610), as the medium access control address for said apparatus in said local area network (see col. 11, line 59-65; a new address is assigned as a new MAC address for PEA 120).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **making the address in the same range**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Even if the limitation is being claimed, "**making the address in the same range** in least one embodiment" is certainly not disclosed or supported by applicant's provisional application.

Regarding miscellaneous issue, the applicant argued that, "...any and all finding of inherency are traversed as not being shown to be necessarily present. Furthermore, and an all finding of well-known art and official notice, or statements interpreted similarly, should not be considered well known..." in page 24.

In response to applicant's argument, the examiner respectfully disagrees with argument as irrelevant since the office action contains no "inherency statement", "well-known art and official notice statement".

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ian N. Moore whose telephone number is 571-272-3085. The examiner can normally be reached on 9:00 AM- 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on 571-272-7629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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